

**REMARKS**

Claims 1-24 are pending in the application.

Claims 1-5 and 7-14 stand rejected.

Claim 6 stands objected to.

**Formal Matters**

Claim 6 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. While Applicants acknowledge the allowability of Claim 6 if rewritten, Applicants respectfully decline to do so at this time but reserve the right to so amend at a later date.

**Rejection of Claims under 35 U.S.C. § 102**

Claims 1, 2, 5, 10, 12-14, 17, 19 and 22 stand rejected under 35 U.S.C. § 102(b), as being anticipated by Abendschein, *et al.*, U.S. Patent No. 5,419,717 (“Abendschein”). Applicants respectfully traverse this rejection.

The Office Action relies on Abendschein in rejecting each of Claims 1, 2, 5, 10, 12-14, 17, 19, and 22. Applicants respectfully submit that the particular parts of Abendschein that the Examiner has relied upon have not been designated as nearly as practicable, and the pertinence of Abendschein has not been clearly explained, both as required by 37 CFR § 1.104(c)(2). Nevertheless, Applicants have made every attempt to respond to the rejections recited in the Office Action.

**Independent Claims 1 and 13:** Applicants respectfully submit that Abendschein does not disclose each limitation of Independent Claims 1 and 13 and therefore cannot anticipate those claims or any claims that depend on Claims 1 and 13. In the below discussion, Applicants further respond to the positions expressed in the Office Action.

Independent Claims 1 and 13 both claim “a network element port,” and both claims contain a limitation “wherein said optical connector interface and said electrical connector interface are associated with said network element port.” Abendschein does not disclose an optical connector interface and electrical connector interface associated with a network element port. Abendschein discloses an electrical signal being provided by an edge card, not a network element port also used by an optical connector. *See* Abendschein 1:16-20. Applicants further note that Abendschein’s disclosure relates to a hybrid optical and edge card connector and not an apparatus comprising an optical connector interface and an electric connector interface used to couple an optical network connector and an electrical network connector to a mounting surface. Any disclosure provided in Abendschein related to an electrical and optical interface does not provide any description of a network element port associated with both the optical connector interface and the electrical connector interface. *See, e.g.,* Abendschein 2:38-44.

For at least the above reasons, Applicants respectfully submit that Claims 1 and 13, and all claims dependent thereon (Claims 2-12 and 14-23), are in condition for allowance and request Examiner’s indication of same. Applicants further submit that independent Claim 24 is also allowable as written for the reasons above and request Examiner’s indication of same.

**Dependent Claims 2 and 14:** Claims 2 and 14 provide a limitation that the “electrical connector interface comprises a registered jack 45 (RJ-45) interface.” Applicants respectfully submit that Abendschein provides no disclosure of an RJ-45 interface. Abendschein only

discloses an electrical interface that is a printed circuit board (PCB) which is vertically and laterally movable within a connector and in the same housing as an optical connector. *See, e.g.*, Abendschein 1:68-2:10; 4:8-30. The electrical connector interface disclosed as element 13 in Figure 2 is configured to receive the disclosed PCB and not an RJ-45 connector. Further, an RJ-45 connector, as claimed, cannot provide the vertical and lateral movement required by Abendschein.

For at least the above reasons, Applicants respectfully submit that Claims 2 and 14, and all claims dependent thereon (Claims 3-12 and 15-23), are in condition for allowance and request Examiner's indication of same.

**Dependent Claims 5 and 17:** Claims 5 and 17 provide a limitation that “an electrical isolation circuit [is] coupled to said RJ-45 interface.” Abendschein provides no disclosure of any electrical isolation circuit coupled to the electrical connector interface. As stated above, the Abendschein disclosure relates primarily to a hybrid connector and not to an interface. Abendschein provides no disclosure of connections to receptor 11 beyond an electric signal being provided by an edge card. Without such disclosure, Abendschein cannot be said to anticipate Claims 5 and 17.

For at least the above reasons, Applicants respectfully submit that Claims 5 and 17, and all claims dependent thereon (Claims 6 and 18), are in condition for allowance and request Examiner's indication of same.

**Dependent Claims 7 and 19:** Claims 7 and 19 provide a limitation that the “optical connector interface and said electrical connector interface are associated with an auto-media detection network element port.” Applicants respectfully submit that Abendschein provides no disclosure of an auto-media detection network element port. As stated above, with respect to

Claims 1 and 13, Abendschein provides no disclosure of a network element port. Further, as stated with respect to Claims 5 and 17, Abendschein provides no disclosure of circuitry connected to receptor 11 and this includes a lack of disclosure related to an auto-media detection network element port.

For at least the above reasons, Applicants respectfully submit that Claims 7 and 19 are in condition for allowance and request Examiner's indication of same.

*Rejection of Claims under 35 U.S.C. § 103*

Claims 3, 4, 8, 9, 11, 15, 16, 20, 21, 23 and 24 stand rejected under 35 U.S.C. § 103(a), as being unpatentable over Abendschein, in view of Chiu, *et al.*, U.S. Patent No. 6,692,159 ("Chiu"). Applicants respectfully traverse these rejections.

The Applicants respectfully submit that the particular part of the Abendschein and Chiu references that the Examiner has relied upon has not been designated as nearly as practicable, and the pertinence of the references has not been clearly explained, both as required by 37 CFR §1.104(c)(2). Nevertheless, Applicants have made every attempt to respond to the rejections cited in the Office Action.

In order for a claim to be rendered invalid under 35 U.S.C. § 103, the subject matter of the claim a whole would have to be obvious to a person of ordinary skill in the art at the time the invention was made. *See* 35 U.S.C. § 103(a). This requires: (1) the reference(s) must teach or suggest all of the claim limitations; (2) there must be some teaching, suggesting or motivation to combine references either in the references themselves or in the knowledge of the art; and (3) there must be a reasonable expectation of success. *See* MPEP 2143; MPEP 2143.03; *In re Rouffet*, 149 F.3d 1350, 1355-56 (Fed. Cir. 1998).

As stated above, Applicants submit that the Abendschein reference does not contain all of the limitations of Independent Claims 1 and 13, nor does it contain all of the limitations of Dependent Claims 2 and 14 (upon which all of the claims rejected under 35 U.S.C. § 103 depend). Further, the Office Action provides no discussion or evidence that Chiu provides any of these missing limitations. For at least these reasons, Applicants respectfully submit that the indicated claims are allowable as claimed and request Examiner's indication of same.

Dependent Claims 3, 4, 15 and 16 are rejected over the combination of Abendschein with Chiu. The Office Action cites Chiu as disclosing an optical connector interface comprising either a small form factor pluggable (SFP) optical module or a gigabit interface converter (GBIC) optical module. But Applicants respectfully submit that the Examiner has not satisfied the burden of factually supporting the alleged motivation to combine the two references. The Examiner's duty may not be satisfied by engaging in impermissible hindsight; any conclusion of obviousness must be reached on the basis of facts gleaned from the references. The Examiner must therefore provide evidence to suggest the combination and "[b]road conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" *See In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Applicants respectfully submit that the particular part of the cited references relied upon by the Examiner and the pertinence of each reference has not been clearly explained, especially with regard to the motivation to combine the references in Office Action sections 4(a) and 4(b). Further, the Office Action does not establish that such a combination of the teachings of these references would meet with success, as required. For example, there is no indication that the connector of Abendschein would successfully couple with an SFP optical module or a GBIC optical module from the standpoint of size.

The Office Action presents nothing more than broad, generalized statements related to the motivation of a person of ordinary skill, which Applicants respectfully submit is insufficient to support a finding of obviousness. Using Applicants' own disclosure as a blueprint for providing the motivation to combine prior art references in an obviousness determination is impermissible. See *W.L. Gore & Assoc. v Garlock*, 721 F.2d 1540, 1552-53 (Fed. Cir. 1983) ("To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher").

The Office Action further does not establish that one would have a reasonable expectation of success in the combination of Abendschein with Chiu. As stated above, it is not clear from the references whether the size of the Abendschein apparatus is compatible with the size of SFP or GBIC optical modules as disclosed in Chiu. Additionally, even should the combination result in incorporation of an SFP or GBIC optical module in the receptor disclosed in Abendschein, it would still not anticipate the claims for the reasons discussed both in this section and in the previous section.

For these reasons and those previously expressed, Applicants respectfully submit that the Office Action fails to present a *prima facie* case of obviousness of Claims 3, 4, 15, and 16, and all claims dependent upon them, and that they are therefore in condition for allowance. Applicants respectfully request the Examiner's reconsideration of the rejection as to those claims.

CONCLUSION

In view of the amendments and remarks set forth herein, the application is believed to be in condition for allowance and a notice to that effect is solicited. Nonetheless, should any issues remain that might be subject to resolution through a telephonic interview, the Examiner is invited to telephone the undersigned at 512-439-5090.

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on March 30, 2005.

  
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3/30/2005  
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Date of Signature

Respectfully submitted,



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